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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/559,091

05/08/2006

Frank L Greenway

Greenway 02P01US

1228

25547

7590

02/27/2009

PATENT DEPARTMENT

TAYLOR, PORTER, BROOKS & PHILLIPS, L.L.P

P.O. BOX 2471

BATON ROUGE, LA 70821-2471

EXAMINER

WINSTON, RANDALL O

ART UNIT

PAPER NUMBER

1655

MAIL DATE

DELIVERY MODE

02/27/2009

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/559,091	Applicant(s) GREENWAY ET AL.	
	Examiner Randall Winston	Art Unit 1655	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 07 January 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 105-135 and 140 is/are pending in the application.
- 4a) Of the above claim(s) 108-135 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 105-107 and 140 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 22 November 2005 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>0506</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Election/Restrictions

Applicant's election with traverse of Group III, claims 105-107 and 140 and the election of species of ellagic acid in its response to the restriction requirement of 12/08/2008 is acknowledged. The traversal is that the single inventive concept of Groups III and IV is the presence of these technical features in the claimed extract of claim 105. Applicants submit that under PCT rules, these two groups should be rejoined. In addition, Groups III and IV should be rejected under the MPEP 821.04.

Applicant's argument is not found persuasive because, as Examiner explained in the previous restriction requirement of 12/08/2008, the inventions are distinct from each other because of the following reasons: The special technical feature of Group III is an anti-angiogenic composition wherein said composition is or is substantially similar to, a composition that elutes from an aqueous extract from blackberry fruit and The special technical feature of Group IV is a method of ameliorating or prevent angiogenesis and/or decreasing the size of an existing capillary network in a mammal comprising administering an effective amount of claim 105. Thus, Groups I and III are an unrelated composition to Groups II and IV methods because the products as claimed can be used in a materially different process of using that product such as treating various diseases such as diabetic retinopathy or malignant tumor growth etc. and thus do not share a special technical feature. For the reasons above, the inventions of Groups III-IV do not share a special technical feature.

The restriction requirement and the election of species requirement are still deemed proper and are therefore made final.

Claims 108-135 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected invention. Claims 105-107 and 140 and the elected species of ellagic acid have been examined on the merits.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 105-107 and 140 are rejected under 35 USC 102(e) as being anticipated by King et al. (US 7208181) and as evidenced by Health and Healing Fact Sheets (website is http://berryhealth.fst.oregonstate.edu/healing/fact_sheets/black_raspberry_facts.htm, see article)

A composition comprising an aqueous extract from black raspberry wherein the black raspberry extract includes ellagic acid therein is apparently claimed.

King anticipates the claimed invention because King teaches a composition comprising an aqueous extract from black raspberry wherein the black raspberry extract includes ellagic acid (see, e.g. entire patent including abstract and example 4) (please note as evidenced by Health and Healing Fact Sheets, black raspberry contains within it a high amount of ellagic acid, see article). Therefore, the reference is deemed to anticipate the claimed invention.

Please note, the intended use of the above claimed composition does not patentably distinguish the composition, per se, since such undisclosed use is inherent to the composition. In order to be limiting, the intended use must create a structural difference between the claimed composition and the prior art composition. In the instant case, the intended use does not create a structural difference, thus the intended use is not limiting (see, e.g., MPEP 2112).

Please also note that the patentability of a product does not depend upon the method of production. If the product in a product-by-process claim is the same as or obvious from a product of the prior art, then the claim is unpatentable even though the prior art product was made by a different process" (see, e.g. MPEP 2113).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Randall Winston whose telephone number is 571-272-0972. The examiner can normally be reached on 8AM-5PM.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Terry McKelvey can be reached on 571-272-0775. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

RW

/Christopher R. Tate/
Primary Examiner, Art Unit 1655